

REMARKS

Claim Rejections

Claims 1 and 7 are rejected under 35 U.S.C. §112, first paragraph. Claims 1 and 7 are rejected under 35 U.S.C. §112, second paragraph. Claims 1-4, 7-9, 11, 13-15, 17 and 19 are rejected under 35 U.S.C. §103(a), as being unpatentable over Applicant's admitted prior art in view of Keely, Jr. et al. (US 6,756,970). Claims 5, 10 and 16 are rejected under 35 U.S.C. §103(a), as being unpatentable over Applicant's admitted prior art in view of Keely, Jr. et al., and further in view of Dening et al. (US Pub No. 2003/0201938). Claims 6, 12 and 18 are rejected under 35 U.S.C. §103(a), as being unpatentable over Applicant's admitted prior art in view of Keely, Jr. et al., and further in view of Gettemy et al. (US 6,603,469).

Amendments to Specification

Applicant has amended the Specification as noted above to remove the wording of "**a single layer**" for complying with the enablement requirement, and to distinctly illustrate that the control chip fabricated on said control circuit board is an **integrated control chip**. Since Fig. 3 as originally filed with the present application clearly shows **the integrated control chip (122) is integrated and fabricated on the control circuit board (116)**, it is believed that no "new matter" has been added to the original disclosure by the foregoing amendment to the Specification.

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

Claim Amendments

By this amendment, Applicant has canceled claims 13 and 19, and amended claims 1, 7 and 14 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. §112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Applicant has reviewed the outstanding office action and believes that the present invention is patentably distinguishable over the primary reference to Keely, Jr. et al., even in view of Dening et al. and Gettemy et al. For the reasons detailed below, the Applicant respectfully requests that the Examiner withdraw the claim rejections under 35 U.S.C. §103.

Claims 1 and 7 have been amended to remove the wording of "a single layer" to obviate the rejection under 35 U.S.C. §112, first paragraph. It is submitted that the claimed subject matter is described in Applicant's specification in sufficient detail to enable one having ordinary skill in the art to make and use Applicant's invention without undue experimentation. It is believed that Applicant's specification discloses how to make and use the claimed invention.

Claims 1, 7 and 14 have been amended to clearly state: **the integrated control chip is integrated and fabricated on the control circuit board**. In the present invention, the specification states, page 9, paragraph [0024]:

It is noted that an integrated control chip 122 is mounted onto the control circuit board 116 for executing the functions of driving the thin film transistors and decoding the signals from the sensor board. Namely the integrated control chip 122 is introduced to provide timing control signals for driving and controlling the thin film transistors, and simultaneously to provide logical functions of decoding and delivering signals from the sensor board 134.

Applicant respectfully submits that the present invention is patentably distinguishable from Keely, Jr. et al. because Keely, Jr. et al. does not teach **the application of the integrated control chip**, nor does Keely, Jr. et al. suggest **the integration of electronics for driving the thin film transistors and the electronics for decoding the signals received by the sensor board into one single circuit board**.

It is noted, as explained in the paragraph [0011] on page 5 of the specification for the present invention, a further objective of the present invention is to provide an integrated control circuit unit for simultaneous **driving the thin film transistors** of the display and **decoding the signals** received by the sensor board.

Namely, the control board of the digitizer and the drive circuit board for driving the thin film transistors, which are fabricated separately in the prior art, are both integrated onto the **single control circuit board** in the present invention.

The examiner interpreted Keely, Jr. et al. to disclose an electronics layer which includes electronics for a display and digitizer layer. However, referring to fig 1 of Keely, Jr. et al., which clearly illustrates the source & gate PCB (22) and the pen controller PCB (72) as being two separated circuit boards. The same is shown in fig 2, the DRIVE ELECTRONICS (22) and the ADD'L ELECTRONICS are fabricated in two separated pieces of circuit boards. Keely, Jr. et al., in column 4, lines 62-67, states:

Next (3), the lines are folded around the layers 10, 16 and 18 and the drive electronics 22 are folded into place behind the grid layer 18. Finally (4), any additional electronics for the display or grid, such as digitizer controller, are fixed in place inboard of the display edges.

Keely, Jr. et al. only disclose the technology described in the background of the present invention, but do not disclose that integrating the electronics for driving the thin film transistors and the electronics for decoding the signals received by the sensor board into one single circuit board.

Even if the teachings of Keely, Jr. et al., Dening et al., and Gettemy et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: an integrated control chip fabricated on said control circuit board to provide timing control signals for driving said thin film transistors and executing a logical function of decoding signals from said sensor board.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Keely, Jr. et al., Dening et al., or Gettemy et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Keely, Jr. et al., Dening et al., nor Gettemy et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

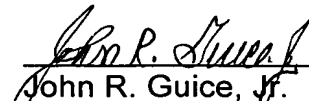
In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claims 13 and 19, thereby rendering moot the outstanding rejections under 35 U.S.C. § 103.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: October 19, 2006

By: _____


John R. Guice, Jr.
Reg. No. 39,699

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707

CUSTOMER NUMBER: 40144